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OFFICE OF PETITIONS

In re Patent of Kawaguchi et al. : DECISION ON APPLICATION
Patent No. 7,531,488 : FOR RECONSIDERATION OF
Issue Date: May 12, 2009 : PATENT TERM ADJUSTMENT
Application No. 09/939,599 :
Filing Date: August 28, 2001 :
Attorney Docket No. 230086US0CONT :
:

This is a decision on the petition filed June 26, 2009, which is being treated as a petition under 37 C.F.R. § 1.705(d) requesting the patent term adjustment indicated on the patent be corrected to indicate the term of the patent is extended or adjusted by one thousand five hundred forty-seven (1,547) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by one thousand five hundred forty-seven (1,547) days is **GRANTED to the extent indicated herein**.

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 C.F.R. § 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, Patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to file any request for reconsideration of the determination of patent term adjustment set forth in this decision. No extensions of time will be granted under 37 C.F.R. § 1.136.

Issue 1

The petition asserts the patent term adjustment should have included an increase of 569 days as a result of delay under 35 U.S.C. § 154(b)(1)(B) ("B Delay"). However, a review of the record indicates the patent term adjustment should have included an increase of 568 days as a result of B Delay.

The petition states the period of B Delay is 1,159 days.

Pursuant to 35 U.S.C. § 154(b)(1)(B)(i), B Delay does not include any time period consumed by continued examination. Although Patentees recognized the need to exclude a time period due to the RCE, Patentees failed to exclude the actual date the RCE was filed from the period of B Delay.

B Delay is 1,158 days, not 1,159 days, after removal of the time period consumed by continued examination but before removal of any time period pursuant to 35 U.S.C. § 154(b)(1)(B)(ii).

Pursuant to 35 U.S.C. § 154(b)(1)(B)(ii), B Delay does not include any time period consumed by appellate review. Therefore, B Delay does not include the 125 days consumed by appellate review as a result of the Notice of Appeal filed June 28, 2007.

B Delay is 1,033 days after the period of time consumed by appellate review is excluded from the period of delay.

The petition asserts the number of days of overlap is 590 days. However, the Office has determined the number of days of overlap is 465 days.

In view of the prior discussion, the patent term adjustment should have included an increase of 568 (1,033 - 465) days as a result of non-overlapping B Delay.

Issue 2

Patentees contend the Office acted improperly when the Office entered a reduction of 41 days under 37 C.F.R. § 1.704(c)(10) for the filing of a Supplemental Application Data Sheet (“ADS”) on March 3, 2009.

Background

The original declaration listed addresses for the assignee as the mailing addresses for the inventors. For example, the declaration listed the mailing address for the first inventor as: “c/o Idemitsu Kosan Co., Ltd., 1280, Kamiizumi Sodegaura-machi, Kimitsu-gun, Chibaken, Japan.” The original declaration identified the residential address for each inventor as “Same as Post Office Address.”

When addresses in Japan are written in English, the last non-numeric term listed before the country’s name is normally a prefecture. The city name is the term immediately preceding the name of the prefecture.

By including a city name as part of the mailing address of each inventor and stating the residential address was the same as the mailing address, the declaration did identify the city of residence for each of the inventors.

The individual at the Office who entered the residential address information for each inventor into Office records appears to have been unfamiliar with the format used when setting forth an address in English on correspondence mailed to Japan. The individual at the Office who entered the residential address information from the declaration assumed the name listed in the address prior to the country name of Japan was the city name for the mailing address. As a result, the individual entered “Chiba-ken” as the city of residence for the first two inventors. The Office entered “Ichihara-shi” as the city of residence for the third inventor. The Office entered Tokyo as the city of residence for the fourth inventor.

A proper interpretation of the declaration is the city of residence is:

- (1) Kimitsu-gun for the first inventor,
- (2) Kimitsu-gun for the second inventor,
- (3) Ichihara-shi for the third inventor, and
- (4) Chiyoda-ku for the fourth inventor.

Although the filing receipt identified the city of residence entered by the Office for each inventor, Patentees did not take any steps to clarify the city of residence for the inventors.

A revocation of the prior power of attorney and a new power of attorney to a customer number associated with the current representatives of record was filed June 17, 2004.

When the Office mailed a Notice of Allowance and a Notice of Allowability on January 30, 2009, the examiner did not recognize the need for clarification of the city of residence for each inventor. As a result, the examiner did not require the submission of a supplemental ADS or supplemental oath or declaration.

Patentees submitted a Supplemental ADS on April 2, 2009, with payment of the issue fee. The ADS clearly indicated the city of residence is:

- (1) Kimitsu-gun for the first inventor,
- (2) Kimitsu-gun for the second inventor,
- (3) Ichihara-shi for the third inventor, and
- (4) Tokyo for the fourth inventor.

The Office notes the declaration and ADS both fail to properly set forth a mailing address for each of the inventors. Specifically, both documents fail to include a postal code as part of the mailing addresses.

The Office entered a reduction of 41 days under 37 C.F.R. § 1.704(c)(10) as a result of the filing of the supplemental ADS after the Office had mailed a Notice of Allowance.

Discussion

37 C.F.R. § 1.704(c)(10) states,

[Upon] [s]ubmission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed ... the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

- (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or
- (ii) Four months.

Clarification of the Office's interpretation of the scope of 37 C.F.R. § 1.704(c)(10) is set forth in Manual of Patent Examining ("MPEP") § 2732 (8th ed., Rev. 7, July 2008). MPEP § 2732 states,

37 CFR 1.704(c)(10) establishes submission of an amendment under 37 CFR 1.312 or other paper after a notice of allowance has been given or mailed as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application.... Certain papers filed after allowance are not considered to be a failure to engage in reasonable efforts to conclude processing or examination of an application. See Clarification of 37 CFR 1.704(c)(10) – Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance has been Mailed, 1247 Off. Gaz. Pat. Office 111 (June 26, 2001).

The submission of the following papers after a "Notice of Allowance" is not considered a failure to engage in reasonable efforts to conclude processing or examination of an application:

- (1) Fee(s) Transmittal (PTOL- 85B);
- (2) Power of Attorney;
- (3) Power to Inspect;
- (4) Change of Address;
- (5) Change of Status (small/not small entity status);
- (6) a response to the examiner's reasons for allowance or a request to correct an error or omission in the "Notice of Allowance" or "Notice of Allowability;" and
- (7) letters related to government interests (e.g., those between NASA and the Office).

Papers that will be considered a failure to engage in reasonable efforts to conclude processing or examination of an application include:

- (1) a request for a refund;
- (2) a status letter;
- (3) amendments under 37 CFR 1.312;
- (4) late priority claims;
- (5) a certified copy of a priority document;
- (6) drawings;
- (7) letters related to biologic deposits; and
- (8) oaths or declarations.

Patentees contend the ADS falls within the "Change of Address" exception listed above.

Although the declaration identified the city of residence, the declaration failed to properly identify the city of residence. The city of residence for an inventor is not properly identified when the city of residence is identified in a manner requiring Office employees to have knowledge of the mailing addressing formats used in other countries in order to recognize the city of residence.

The Office contends the failure by the declaration to clearly identify the city of residence is tantamount to a failure to include the city of residence in the declaration. In practical terms, the ADS was a paper submitting the city of residence for the very first time, not a paper changing the city of residence properly supplied in the declaration. MPEP § 2732 does not include an exception for an ADS providing residential addresses for inventors for the first time.

Even if the Office determined the original declaration properly provided the city of residence for each inventor, the ADS would not be a paper that only changed the residential address for each inventor. The ADS only changed the city of residence for the fourth inventor. The ADS clarified, but did *not* change, the city of residence for the other three inventors.

Patentees argue an ADS that only changes address information for inventors falls within the scope of a “Change of Address.” However, Patentees fail to discuss the inconsistency such an interpretation could create within the provisions of MPEP § 2732

MPEP § 2732 explicitly states the submission of an oath or declaration after allowance will be considered a failure to engage in reasonable efforts to conclude processing or examination of the application. If a supplemental declaration that only changes address information for an inventor is filed after allowance, adopting Patentee’s interpretation of “Change of Address” would result in the declaration falling within a group of papers explicitly listed as not resulting in a reduction while at the same time falling within a group of papers the Office has explicitly indicated will result in a reduction.

In view of the prior discussion, the Office acted properly when the Office entered a reduction of 41 days under 37 C.F.R. § 1.704(c)(10) as a result of the filing of the supplemental ADS after the Office had mailed a Notice of Allowance.

Conclusion

The period of A Delay is 1,260 days.

The period of B Delay is 1,033 days.

The amount of overlap between A and B Delay is 465 days.

The period of Applicant Delay is 323 days and properly includes a 41-day reduction under 37 C.F.R. § 1.704(c)(10).

The patent term adjustment for the patent is 1,505 days which is the sum of 1,260 days of A Delay and 1,033 days of B Delay reduced by 465 days of overlap and 323 days of Applicant Delay.

The Office acknowledges submission of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e). No additional fees are required.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the patent is extended or adjusted by **one thousand five hundred five (1,505) days.**

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.



Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of Draft Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO. : 7,531,488 B2

ISSUE DATE : May 12, 2009

DRAFT

INVENTOR(S) : Kawaguchi et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 937 days.

Delete the phrase "by 937 days" and insert - by 1505 days--